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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,966	03/19/2002	Hiromi Ukai	62807-015	7234

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McDermott, Will & Emery  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
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CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/099,966	UKAI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11,13,15,17,20,21 and 23-39 is/are pending in the application.
- 4a) Of the above claim(s) 20,23,25,36 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11,13,15,17,21,24,26-35,37 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This action is responsive to the paper(s) filed 4/30/07.

### ***Election/Restrictions***

Newly submitted claims 20, 23, 25, 36, 39 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- Claims 36, 39 require delivery of the coupon to a cellular phone, yet the previously examined claims (e.g. claim 13) require delivery of the coupon to the receiver.
- Claims 20, 23, 25 require delivery of the coupon information via a different broadcasting band, yet the previously examined claims (e.g. claim 11) require the coupon information to be sent together with the program/commercial message.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 36, 39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 20, 21, 23-27, 29, 31-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 20, 21, 23-27, 29, 31-39 provide apparatus/system claims which should set forth programmed capabilities rather than method steps. Applicant should specify elements programmed to (or configured to) accomplish a function, rather than claim performance of such function. Applicant should claim for example that “the transmitter is programmed to (or configured to) broadcast” rather than claiming “the transmitter broadcasts”.
- Claim 23, it is unclear how a coupon can be broadcasted, especially at the time when the program or commercial message is broadcasted. Applicant should apparently claim transmission capabilities of the coupon *information* – not the actual coupon; the coupon is sent subsequent to a coupon request.
- Claims 32, 33, If applicant desires to include features regarding an element capable of receiving an EPG, he should do so positively in the claims. Claiming attachment capabilities by hinting that EPG information happened to be received by the receiver does not positively set forth the capability in the receiver for receiving such information.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**5. Claims 11, 13, 15, 17, 28-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Spector (US 2006/0100929).**

Regarding claims 11, 15, 29, Spector teaches a user's TV receiving device that receives broadcasted/transmitted television content including a commercial. The customer is given the chance to request a coupon for the product offered in the commercial and he may make such a request using the remote control [para 32]. The presence of the commercial itself represents coupon information that a coupon request can be made. The request includes an identification of the product, viewer profile information and timing information and what specific commercial was being shown at the time [para 16, 22, 30, 33]. A coupon is then retrieved from coupon storage and issued based on the request [37]. A central host computer also monitors the number of coupon responses (requests) and redemptions in order to manage and nimbly makes changes to the coupon campaign operations [para 23, 24, 34, 35, 39]. The steps of reactively modifying a particular product's coupon campaign based upon collected coupon usage (responses and redemptions) inherently provides a calculation regarding the number of issuances and redemptions for that product/commercial's coupons. As the coupon requests are tied to a specifically identified product commercial (using embedded identification information), it can be said that Spector calculates a number of issued coupons for the commercial message on the basis of the extracted identifier.

Regarding the “determining a period, number of times or a fee, for the broadcasting or transmitting of the program or commercial message”, the ability to calculate a number of issuances of coupons inherently provides a number of minimum times that the corresponding commercial was broadcasted and/or viewed, therefore meeting this limitation.

Regarding claims 13, 17, Spector teaches receiving usage (redemption) information [para 34]. Again, the steps of reactively modifying a particular product's coupon campaign based upon collected coupon usage (responses and redemptions) inherently provides a calculation regarding the number of issuances and redemptions for that product/commercial's coupons. Regarding the “determining a period, number of times or a fee, for the broadcasting or transmitting of the program or commercial message”, the ability to calculate a number of redemptions of coupons inherently provides a number of minimum times that the corresponding commercial was viewed, therefore meeting this limitation.

Regarding claims 28, 30, Spector teaches including the time of the commercial as part of the coupon request [para 30].

Regarding claims 32, 33, Spector teaches that the TV receivers are personal video recorders (PVRs) and that these devices allow a user to record a plurality of shows and watch them later. In particular, the shows are indexed for later selection/viewing. This indexing and inherent user interface which enables particular shows to be selected from a list of recorded shows is taken to provide an electronic program guide which identifies each show. The ability to request from a host a coupon related to a particular broadcasted commercial using such a PVR is therefore taken to

include identification of the time/show being viewed so that the proper coupon can be issued.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claims 31, 35, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector.**

Regarding claims 31, 35, 38, Spector teaches that demographic profile information is sent as part of the request [para 22, 30, 33] and that this demographic profile information is used to target the coupon. Spector also mentions that it is known to analyze television-delivered coupons to determine usage of the coupons and the demographics of usage [0013]. Spector also teaches that coupons requested via the television system can be analyzed according to how the product is selling in a particular area or to a defined consumer group/segment. Spector however does not specifically teach gender or age. However, Official Notice is taken that it is well known to collect demographic information (including gender, age and other characteristics) about coupon users (as well as television viewers) in order to provide insight to the coupon (and TV) behavior of various demographic segments. It would have been obvious to one of ordinary skill at the time of the invention to have determined the coupon and/or

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TV behavior of various demographically-segmented users' according to their regions (obvious that time zone of program can define a region) of Spector in order to use the gained knowledge for better marketing decisions when dealing with these groups of consumers. Regarding the times of the issuances and redemptions, Spector teaches that the coupon offers are short life coupons which indicates the need to calculate redemption-issue times to verify the validity of the short-life coupon. Further, the dynamic nature of Spector's system that adapts according to recent coupon issuances and redemptions inherently requires time/date-indications of the coupons' issuances and redemptions.

**8. Claims 21, 24, 26, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector in view of Benthin et al (US20020035568).**

9. Regarding claims 21, 24, 26, 27, Benthin et al et al also teaches electronic delivery of promotions via marketing campaigns. Benthin et al teaches a system that can monitor the consumer response to promotional campaigns and can edit a campaign accordingly, including continuing/extending a campaign which has shown to be successful (i.e. as responses increase). It would have been obvious to one of ordinary skill at the time of the invention to have extending the campaign durations for the campaigns of Spector which have seen success (i.e. large responses).

**10. Claims 34, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector in view of Lemon et al (US4674041).**



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Regarding claims 34, 37, Lemon et al teaches that a coupon campaign may include a threshold specifying the number of coupons to be issued overall [2:13-20]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a limit with that of Spector so that the provider of the coupons does not over-extend his offers.

**11. Claims 11, 13, 15, 17, 20, 21 and 23-33 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Spector as above and further in view of Kitsukawa et al (US6282713).**

Kitsukawa et al also teaches delivery of electronic coupons to users via broadcast television content. Kitsukawa et al teaches that the user can be notified of the availability of a coupon, that the user can select the coupon and that the system will store information concerning the broadcasted content when the coupons were delivered - program title, program description, air date/time and channel [11:48-54]. Upon redemption, this data is accessed and the central host includes storage of these coupon identifiers along with the broadcast content information [12:9-20] to allow for "statistical television data." It would have been obvious to one of ordinary skill at the time of the invention to modified Spector to collect and analyze the TV programming data which acted as a source of the requested or issued coupons so that marketing decision makers can better understand the TV programming, TV audience behavior, and their participation in the coupon campaign, in order to optimize future coupon campaigns. It would have been obvious to one of ordinary skill at the time of the invention to have collected statistical television data as suggested by Kitsukawa et al in order to

determine the relative success of the coupons (number of requests, number of redemptions, elapsed time before redemption) for each of the associated broadcasts in order to provide basic Marketing insight, especially as Spector notes desires for demographic and regional analysis and applicant has indicated that audience rate of a broadcast program has conventionally been used [spec page 2 lines 10-12].

While the notion set forth above that Spector's ability to calculate a number of issuances/redemptions of coupons inherently provides a number of minimum times that the corresponding commercial was broadcasted/viewed indeed meets the determining a period, times or fee limitation, Kitsukawa et al clearly teaches the idea of studying TV-coupon requests/issuances and redemptions in order to provide marketing analysis regarding both couponing and television viewing. Official Notice is taken that it is generally accepted practice to charge advertisers for the service of broadcasting advertisements. It would have been obvious to one of ordinary skill at the time of the invention to have charged the manufacturers of the products in the broadcasted coupons according to the quantity of coupons that were broadcast, issued and/or redeemed on their behalf. In this manner, the advertiser pays a fee that is commensurate in scope with the advertising/coupon/promotional broadcast service.

Regarding claim 29 in particular, Kitsukawa et al teaches that several coupons can be available at a single time for a TV viewer. Kitsukawa et al provides storage of coupons by way of pointers that enables the plural coupons to be managed and more specifically to be uniquely identified [col 6 lines 5-13]. It would have been obvious to one of ordinary skill at the time of the invention to have inserted a coupon identifier at the host of Spector so that the programs/commercials can be broadcasted with

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embedded coupon identifiers, allowing users to accurately identify desired coupon when plural coupons are shown at the same time.

Regarding claims 32, 33, Kitsukawa et al teaches that program content is classified (i.e. identified) by the receiver's electronic program guide (EPG) [col 5 lines 32-35]. It would have been obvious to one of ordinary skill at the time of the invention to have used such identification data in order to notify the host of the program being watched in association with the requested coupon in order to enable the statistical analysis of uniquely identified coupons and related programming as desired by Kitsukawa et al.

**12. Claims 34, 37 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Spector as above and further in view of Kitsukawa et al (US6282713) and Lemon et al.**

Regarding claims 34, 37, Lemon et al teaches that a coupon campaign may include a threshold specifying the number of coupons to be issued overall [2:13-20]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a limit with that of Spector so that the provider of the coupons does not over-extend his offers.

### ***Response To Arguments***

Applicant argues that simply calculating the number of issuances does not meet the claim language. Examiner disagrees. The claim language provides a means for determining (a value), but says nothing about how to put that value to use. Applicant is

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wrong when he argues that there is "management" corresponding to the determination. Applicant's argument that the determined [value] is *to be applied to the broadcasting* reflects applicant's *intentions* with the determined values, but does not positively require such management.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc